

REMARKS

Claims 1-17 are currently pending in the application. Reconsideration in view of the following remarks is respectfully requested.

35 U.S.C. §102 and §103 Rejection

Claims 1 and 2 were rejected under 35 U.S.C. §102(e) for being anticipated by U. S. Patent No. 6,768,789 to Wilk. Claims 3, 6, 7, 11 and 15 were rejected under §103(a) as being unpatentable over Wilk in view of U.S. Patent Publication No. 2002/0009184 to Shnier. Claim 4 was rejected under §103(a) as being unpatentable over Wilk in view of U.S. Patent No. 6,216,016 to Cronin. Claims 5, 8, 9, 10, 12-14, 16 and 17 were rejected under §103(a) as being unpatentable over Wilk in view of U.S. Patent No. 6,009,444 to Chen.

Applicants submit that the rejections of claims 1-17 are rendered moot in view of the submitted Declaration under 37 C.F.R. § 1.131, by the named inventors.

Under §1.131, a rejection under 35 U.S.C. §102(a) or §103 based on a patent may, upon a proper showing, be overcome by removing the patent as a reference against the claims. Applicants submit that the §1.131 Declaration submitted herewith is sufficient to remove the Wilk patent under the §102(e) rejection and the primary reference of the Wilk patent under the §103(a) rejection as references and thus is sufficient to overcome the above-noted rejections.

More specifically, Applicants submit that the §1.131 Declaration is formally and substantively sufficient to establish that the Inventors had completed the invention defined in at least independent claims 1, 5, 10 and 14 in the United States before the U.S. effective date of the Wilk reference, i.e., November 22, 2000. The statements in the Declaration show that the formal requirements of §1.131 are satisfied, namely:

- (1) the rejections to be overcome are under §102(e) and §103(a),
- (2) all the acts for completing the invention of at least independent claims 1, 5, 10 and 14, and those claims

dependent thereon were performed in the United States, and

(3) the U.S. effective date of the Wilk (i.e., November 22, 2000) is not more than one year prior to the effective filing date of the present application.

It is respectfully submitted that the statements in the Declaration are also sufficient to satisfy the substantive requirements of 37 C.F.R. § 1.131. The Declaration sets forth specific facts, of sufficient character and weight, to establish a **date of conception** before November 22, 2000, the effective date of the Wilk reference, and to show that the Inventors and their attorneys exercised **due diligence** from a time before the effective filing date of the Wilk reference to a constructive reduction to practice, i.e., to the filing date of the application in the United States on April 3, 2001.

DATE OF CONCEPTION

An IBM Invention Disclosure is submitted with the Declaration as supporting evidence of this prior date of conception. It is respectfully submitted that the Invention Disclosure shows that the Inventors had a definite and permanent idea of the complete and operative invention of all the pending claims 1-17 prior to November 22, 2000, the effective date of the Wilk reference.

In particular, the Invention Disclosure shows the features of independent claims 1, 5, 10 and 14 (and dependent claims). Also, Applicants note that the original Invention Disclosure shows a date antedating the November 22, 2000 effective date of the Wilk reference. This and all other pertinent dates have been removed from the photocopies of the Invention Disclosure submitted with the Declaration to prevent any potential prejudice to Applicants.

Applicants further submit that the Declaration filed herewith shows, unequivocally, that the Inventors had in their possession a definite and permanent idea of the complete and operative invention of the pending claims before November 22, 2000 in a manner sufficient to satisfy the requirements of conception, as set forth in M.P.E.P. §§ 715.07 and 2138.04, and thus constitute

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prima facie evidence of Applicants' date of conception of the invention in this country before the effective date of the Wilk reference.

DUE DILIGENCE

Applicants further submit that the Declaration shows the Inventors and their attorneys exercised due diligence from a time before the November 22, 2000 effective date of the Wilk reference to a constructive reduction to practice, realized by the filing of the above-identified parent application on April 3, 2001 in the United States.

The Invention Disclosure was forwarded to outside counsel in a timely manner prior to the effective date of the Wilk reference. Communications between the in-house counsel, inventors and counsel took place on several occasions including at least October 16, 2000, February 16, 2001, March 27, 2001 and March 28, 2001 until a final application was forwarded to the Inventors for execution, and subsequent filing on April 3, 2001.

Counsel acted in an expeditious manner to prepare the application for filing. Under M.P.E.P. §2138.06, only *reasonable* diligence is required in this regard. More specifically, §2138.06 states that a patent attorney will be held to have exercised reasonable diligence if the attorney worked reasonably hard on the application during the critical period, taking into consideration any backlog of unrelated cases the attorney may have had and his completion of those cases along with the present application in chronological order. Applicants respectfully submit that the Declaration shows that counsel acted sufficiently expeditiously to satisfy the requirements of due diligence.

Applicants submit that the Declaration submitted herewith is sufficient to show that due diligence was exercised as required under 37 C.F.R. §1.131. The Inventors remained in regular contact with counsel to answer questions, provide technical explanation, and supply the supplemental disclosure materials necessary for allowing the application to be filed in an expeditious manner.

Accordingly, Applicants respectfully request that the rejection over claims 1-17 be

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withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to IBM Deposit Account No. 50-0510.

Respectfully submitted,

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